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08/914,743	08/19/1997	MICHAEL KENNETH CERRETA	6586R	9009

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THE PROCTER & GAMBLE COMPANY  
INTELLECTUAL PROPERTY DIVISION  
WINTON HILL TECHNICAL CENTER - BOX 161  
6110 CENTER HILL AVENUE  
CINCINNATI, OH 45224

EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 26

Application Number: 08/914,743  
Filing Date: August 19, 1997  
Appellant(s): CERRETA ET AL.

*date mailed*  
*12/18/02*

\_\_\_\_\_  
Erich D. Hemm  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 15, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of Claims 1-19 and 41-54 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 1-19 and 41-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elsen et al (US Patent No. 5,422,131).

Applicants claim a flowable nondigestible oil composition comprising a liquid polyol fatty acid polyester having a complete melt point less than 37°C, and a crystallized solid polyol fatty acid polyester having a complete melt point of at least about 37°C, said solid polyol fatty acid polyester comprising a plurality of crystallized spherulites comprising a solid saturated polyol polyester within the liquid polyol fatty acid polyester, wherein particles of said crystallized solid polyol fatty acid polyester have a diameter of from about 1 microns to about 50 microns, and wherein the flowable nondigestible oil composition has a Consistency in a temperature range of 20-40°C in the range of from about 0 P•sec(n-1) to about 30 P•sec(n-1), and wherein the solid polyol fatty acid polyester is crystallized while shearing the nondigestible oil.

The Elsen et al patent discloses nondigestible fat compositions comprising a liquid nondigestible oil component having dispersed therein nondigestible solid polyol polyester particles in an amount sufficient to control passive oil loss upon ingestion of the nondigestible fat compositions. Elsen et al discloses that the liquid nondigestible oil component of the compositions is one that has a complete melting point below about 37°C. Elsen et al further discloses that the polyol polyesters that can be used to form the nondigestible solid particles used as oil loss control agents in the composition are those that have a complete melting point above about 37°C but below about 500°C (see column 3, lines 27-59). See column 2, lines 60-63 wherein Elsen et al suggests that solid polyol polyester in the form of spherulitic particles and typically from about 3 to about 32 microns in size is well known in the art. This size of the solid polyol polyester disclosed in the Elsen et al patent embraces the diameter of 1 microns to about 50 microns that is set forth in instant Claims 1, 2, 15, 41 and 47. Elsen et al discloses that

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the preferred liquid nondigestible oils are the liquid polyol polyesters that comprised liquid sugar polyesters, liquid sugar alcohol polyesters, and mixtures thereof. The preferred sugars and sugar alcohols disclosed by Elsen et al for preparing these liquid polyol polyesters include erythritol, xylitol, sorbitol, and glucose, with sucrose being especially preferred (see column 7, lines 44-61). The "polyol polyester" used by Elsen et al includes a polyol having at least 4 ester groups, i.e., at least 4 of the hydroxyl groups of the polyol are esterified with fatty or other organic acids (see column 6, lines 31-52). The "ester group" used by Elsen et al includes a moiety formed from the reaction of a hydroxyl group with an organic acid or acid derivative, which moiety contains fatty acid and/or other organic radicals having at least 2 carbon atoms, typically at least 8 carbon atoms, more typically at least 12 carbon atoms, most typically at least 16 carbon atoms (see column 6, line 53 to column 7, line 12). In column 7, line 68 to column 8, line 6 Elsen et al discloses that for those liquid polyol polyesters having high proportions of unsaturated C18 or higher fatty acid radicals, at least about half of the fatty acids incorporated into the polyester molecule are typically unsaturated. Elsen et al further discloses that preferred unsaturated fatty acids in such liquid polyol polyesters are oleic acid, linoleic acid, and mixtures thereof. This passage in the Elsen et al patent embraces the subject of instant Claims 17-19. In instant Claim 17, the polyol is indicated as sucrose, which is embraced in the Elsen et al patent since the Elsen et al discloses sucrose at the 2<sup>nd</sup> paragraph of column 8. The Elsen patent discloses at column 13, lines 27-32 a molar ratio of dissimilar acid radicals to long chain saturated fatty acid radicals ranging from about 1:15 to about 2:1, wherein the dissimilar acid radicals includes long chain unsaturated fatty acid esters (see column 12, line 47 and 48 of the Elsen et al patent). This ratio covers the ratio set forth in instant Claims 18, 19, 52 and 53 when the dissimilar acid radical represents long chain unsaturated fatty acid esters. See column 22, line 58 to column 23, line 9 wherein Elsen et al contemplates viscosity values by determining the Thixotropic Area Values of nondigestible fat compositions thereof. These viscosity values appear to embrace the viscosity values set forth in instant Claims 7-11 and 42. See column 21, lines 31-34 wherein Elsen et al discloses an example of a polyol polyester hardstock having a

melting point of about 60°C, which embraces the solid saturated polyol polyester melt point of at least about 60°C that is set forth in instant Claims 12 and 50. See column 22, line 12 wherein the Elsen et al patent discloses spherulitic particles as a result of co-crystallization, which embraces the crystallized aggregated spherulites disclosed in instant Claim 15. The subject matter of instant Claims 16 and 54 which discloses the nondigestible oil composition comprises temperature sensitive food additives is contemplated in the Elsen et al patent since Elsen et al teaches at column 21, last line to column 22, line 8 the forming of nondigestible fat compositions within a food product. Elsen et al discloses that typically, the nondigestible fat composition so formed will comprise from about 60% to about 99% liquid nondigestible oil, and from about 1% to about 40% particles of solid polyol polyester or cocrystallizable blend (see column 20, lines 43-47), which is analogous to the amount of liquid and solid particles set forth in the instant claims (see Claims 6 and 46). The nondigestible composition disclosed in the instant claims differs from the nondigestible compositions disclosed in the Elsen et al reference in the recitation of the compositions having "a Consistency in a temperature range of 20-40°C in the range of from about 0 P•sec(n-1) to about 30 P•sec(n-1)", which is not recited in the Elsen et al patent. However, it is noted that all the other features of the instantly claimed nondigestible oil composition that are disclosed in instant Claim 1 that appears to directly or indirectly determine the Consistency of the nondigestible oil composition are set forth for the nondigestible fat compositions of the Elsen et al patent. For example, the Elsen et al patent discloses a nondigestible fat composition that comprises liquid polyol fatty acid polyesters having a melting point less than 37°C, a solid polyol fatty acid polyester having a melt point above 37°C, and solid polyol fatty acid polyesters having a diameter between 1 and 50 microns, as instantly claimed. Without a side-by-side comparison between the nondigestible oil composition of the instant claims with the nondigestible fat composition that is disclosed in the Elsen et al patent that shows patentably distinct characteristics between the compositions, there is no reason for one of ordinary skill in the art to indicate an obvious patentable difference between the compositions. Accordingly, it would have been obvious to one of ordinary skill in the art having the Elsen et al patent before him to obtain the instantly claimed

nondigestible composition in view of their closely related structures of the components of the compositions and the resulting expectation of similar organoleptic properties for food prepared with the nondigestible compositions.

**(11) Response to Argument**

Applicant's arguments filed August 15, 2002 have been fully considered but they are not persuasive. On page 4 of the Brief, Applicants argue that there is not a reasonable expectation of success of obtaining the claimed invention based upon the Elsen et al patent because the Elsen et al patent does not disclose that the nondigestible composition thereof has a Consistency within the temperature range of 20°C to 40°C of less than about 50 P•sec(n-1) as set forth in the instant claims. This argument is not persuasive because the Elsen et al patent discloses a nondigestible composition that comprises overlapping chemical features that affect the Consistency of the composition that include liquid polyol fatty acid polyesters having a melting point less than 37°C, a solid polyol fatty acid polyester having a melting point above 37°C, and solid polyol fatty acid polyesters having a diameter between 1 and 50 microns. These features indicated in the Elsen et al patent are also claimed features for the nondigestible composition of the instant claims. Since these features between the nondigestible composition of the instant claims and Elsen et al patent are substantially overlapping, a reasonable expectation of success of obtaining the claimed invention can be appreciated. One of ordinary skill in the art would expect nondigestible compositions that have the indicated features in common would have inherently similar Consistency values.

Applicants also argue on page 5 of the Brief that there is no motivation to modify the Elsen et al patent to obtain the claimed invention since the Elsen et al patent does not address the problem of providing a nondigestible composition having a Consistency within the temperature range of 20°C to 40°C of less than about 50 P•sec(n-1). The Elsen et al patent does not disclose a measurement for Consistency of the nondigestible composition thereof. However, the Elsen et al patent does disclose

other features of the nondigestible composition that embrace the nondigestible composition of the instant claims. For example, the Elsen et al patent does provide a nondigestible composition that has features that include liquid polyol fatty acid polyesters having a melting point less than 37°C, a solid polyol fatty acid polyester having a melting point above 37°C which is disclosed in the instant claims, a solid polyol fatty acid polyester which particles have a diameter between 3 and 32 microns, which is within the range of the particles having a diameter from about 1 micron to about 50 microns in the instant claims. The Elsen patent discloses a nondigestible composition that comprise from about 60% to about 99% liquid nondigestible oil, and from about 1% to about 40% of particles of solid polyol polyester, which falls within the range of the instantly claimed nondigestible composition comprising 50-99% of a liquid polyol polyester and 1-50% of a solid polyol polyester. The makeup of the "liquid nondigestible oil" in the Elsen patent is analogous to the makeup of the "liquid polyol polyester" of the instant claims. Since the nondigestible composition of the Elsen patent has the indicated features in common with the nondigestible composition of the instant claims, one would indeed be motivated to use the information set forth in the Elsen patent to obtain the instantly claimed nondigestible liquid composition. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants argue that the Elsen patent does not teaches or suggests all the claim limitations. This argument is not persuasive since the Elsen patent does disclose all the features of the claimed invention except measurements indicating the Consistency of the claimed composition. However, the description of the other characteristics of the claimed invention by the Elsen patent suggests that the Consistency value disclosed in



the instant claims is an inherent feature of the composition of the Elsen patent since virtually all the other features of the claimed invention are seen in the Elsen patent.

Applicants argue that even-though Elsen does teaches a nondigestible composition comprised of a solid portion and a liquid portion, there is no indication that the claimed flowability characteristic would necessarily result after these ingredients are combined. This argument is not persuasive since the Elsen patent discloses in column 20, lines 43-47, that the nondigestible composition thereof comprises from 60% to about 99% liquid nondigestible oil, and from about 15 to about 40% of solid polyol polyester particles, which is a clear indicator that the nondigestible composition of the Elsen patent comprises flowability characteristic. See Claim 6 of the instant application wherein the instantly claimed nondigestible oil composition comprises, by weight, 50-99% of liquid polyol fatty acid polyester, and 1-50% of solid polyol fatty acid polyester.

Applicants further argue on page 5 of the Brief that the Elsen et al patent does not establish a prima facie case of obviousness because the Elsen et al patent does not teaches or suggests nondigestible oil compositions that have a Consistency of less than about  $50 \text{ P} \cdot \text{sec}^{(n-1)}$  within the temperature range of  $20^{\circ}\text{C}$  to  $40^{\circ}\text{C}$ . This argument is not persuasive because the Elsen et al patent discloses features, as indicated above, of nondigestible compositions that are analogous to features that are claimed for the instantly claimed nondigestible composition. The Elsen et al patent establishes a prima facie case of obviousness since the indicated common features of the nondigestible composition of the instant claims and the Elsen et al patent suggest that the nondigestible composition of the Elsen et al patent has a Consistency value that is equivalent to the Consistency value indicated in the instant claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



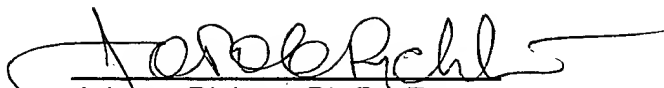
James O. Wilson  
Supervisory Primary Examiner  
**Technology Center 1600**

December 16, 2002

Conferees



Samuel Barts, Ph.D.  
Primary Examiner  
**Technology Center 1600**



Johann Richter, Ph.D., Esq.  
Supervisory Primary Examiner  
**Technology Center 1600**

THE PROCTER & GAMBLE COMPANY  
PATENT DIVISION  
IVORYDALE TECHNICAL CENTER - BOX 474  
5299 SPRING GROVE AVENUE  
CINCINNATI, OH 45217

ew